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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/853,568	08/03/2001	Catherine Shoemaker	1960-00100	6318

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CONLEY ROSE & TAYON, P.C.  
P. O. BOX 3267  
HOUSTON, TX 77253-3267

EXAMINER

CARTER, MONICA SMITH

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 07/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/853,568

Applicant(s)

SHOEMAKER, CATHERINE

Examiner

Monica S. Carter

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-11 and 13-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-11 and 13-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 6/4/02 is: a) ☐ approved b) ☒ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Drawings***

1. The proposed drawing correction filed on June 4, 2002 has been disapproved because it is not in the form of a pen-and-ink sketch showing changes in red ink or with the changes otherwise highlighted. See MPEP § 608.02(v).

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 2 and 4-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, there is an inconsistency between the language in the preamble and a certain portion or portions of the body of the claim, thereby making the scope of the claim indefinite and unclear. Applicant is required to clarify what subject matter the claim is intended to be drawn to, i.e., either the subcombination of an iconic label alone or the combination of a housing, a cover, and an iconic label, and that the language of the claim be amended to be consistent with this intent. A receptacle does not require the use of a label; however, a housing and a cover would be included in a receptacle. For the purpose of prosecution, the Examiner is considering the claims as combination claims.

Claims 2 and 4-6 depend from claim 1 and, therefore, are also rejected accordingly.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2 and 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Mayfield ('702).

Mayfield discloses the claimed invention including a housing inherently having an open end (end which the medicine is to be entered) and an external surface (outside surface of the medication container), the housing is configured to retain dosages of medicine; a cover removably secured to the open end which separates the medicine held within from the outside environment; and a descriptive iconic label (22) disposed on the cover to graphically describe the medicine held therein (see figs. 4 and 5 and col. 7, lines 39-41). The prescription description (Rx) on the label would indicate the enclosed medicine without reference to another source.

Regarding claim 2, Mayfield discloses an iconic label disposed on the external surface (see figs. 4 and 5 and col. 7, lines 42-46).

Regarding claims 17 and 18, the icon is descriptive and non-textual as seen in figures 4 and 5.

Regarding claim 19, see the above rejections.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4-16, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayfield, as used above.

Regarding claims 7-10, Mayfield discloses the method of applying the label (22) to the exterior of the receptacle (col. 7, lines 36-38).

Regarding claim 11, the label has first and second sides, the first side having an adhering surface (col. 7, lines 31-33) and the second side having an external printable media (22).

Mayfield discloses the claimed invention except for the specific arrangement and/or content of indicia (printed matter) set forth in claims 4-9, 11-16, 20 and 21. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any type of graphic representation on the cover, since it would only depend on the intended use of the assembly and the desired information to be displayed.

Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. In re Gulack 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of iconic label does not alter the functional

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relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate which is required for patentability.

### ***Response to Arguments***

8. Applicant's arguments filed June 4, 2002 have been fully considered but they are not persuasive.

Applicant argues that the amendment to the preamble of claim 1 cures the inconsistencies as stated in the previous Office action. The Examiner disagrees. The preamble of claim 1 set forth "A receptacle for medicine". While it is inherently known that a receptacle would have a housing and a cover, it can not be concluded that the receptacle would include a label. Therefore, the Examiner maintains the rejections under 35 USC § 112, 2<sup>nd</sup> paragraph.

Applicant remarked that claim 1 is amended and that the 35 USC § 102 rejection should be withdrawn. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Applicant argues that Mayfield fails to disclose specific arrangement and/or content of indicia as claimed. While Mayfield does not explicitly disclose the particular

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arrangement and/or content of the indicia as claimed, it would have been obvious to provide any type of indicia on the label as desired by the end user depending on the intended use of the device. The indicia on the label, as claimed, does not functionally alter the relationship of the label and the indicia thereon.

Applicant further argues that the geometric shapes on the tabs 22 of Mayfield perform a different function than applicant's label. In response to applicant's argument, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Applicant argues that Mayfield requires that the geometric shapes correspond to geometric shapes on a chart and only through the use of the chart coupled with the geometric shape on the label that one knows what prescription is contained in the bottle. While Mayfield does disclose the use of a chart having corresponding geometric shapes as those located on the label, the label itself comprises information (i.e. Rx, name of medication on the label, etc. as seen in figures 4 and 5) that would indicate the type of medication inside of the container.

Applicant argues that the use of *In re Gulack* is not proper with respect to the present invention. The applicant further argues that the present invention provides a new and

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unobvious functional relationship having a descriptive graphic representation that itself depicts the medicine. The Examiner disagrees. The Examiner maintains that the indicia on the label of the receptacle does not provide any new and unobvious functional relationship. Applicant is merely arguing the intended use of the invention. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In the present case, the medication container of Mayfield is clearly capable of performing the intended use of providing a label having indicia that identifies the medicine in the container.

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the



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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (703) 305-0305. The examiner can normally be reached on Monday-Thursday (8:00 AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

*mc*

mc

June 28, 2002

*A. L. Wellington*  
A. L. WELLINGTON  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700